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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,364	11/29/2000	Travis Nichols	688-098	3368

7590 04/27/2007  
Sofer & Haroun LLP  
317 Madison Ave. Ste. 910  
New York, NY 10017

EXAMINER
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PAYER, HWEI SIU CHOU

ART UNIT	PAPER NUMBER
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3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

14

<b>Office Action Summary</b>	<b>Application No.</b> 09/727,364	<b>Applicant(s)</b> NICHOLS ET AL.	
	<b>Examiner</b> Hwei-Siu C. Payer	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 and 10 is/are rejected.
- 7) ☒ Claim(s) 1-8 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11-29-2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- 1. ☐ Certified copies of the priority documents have been received.
  - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **Detailed Action**

Applicants' election of invention Species I (Figs.1-4) in the reply filed on 7-5-2006 is acknowledged. Upon further consideration, the restriction requirement as set forth in the previous Office action has been withdrawn.

### **Objection to Oath/Declaration**

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

The statement of duty to disclose in the oath/declaration filed on 6-18-01 is incorrect. The correct statement should read "I acknowledge the duty to disclose information which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56."

### **Objection to the Abstract**

The abstract of the disclosure is objected to because the form and legal phraseology often used in patent claims, such as "means" should be avoided.

Correction is required. See MPEP § 608.01(b).

### **Drawings Objection**

1. The drawings are objected to because:

(1) The lines and numbers are not uniformly thick and well defined (poor line quality).

(2) In Fig.4, reference numeral "24" (the one above reference "20") should read -- 22-- (i.e. a bore rather than a lip).

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the ball bearing as cited in claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Objection to the Specification**

The disclosure is objected to because of the following informalities:

(1) On page 7, line 7, "handle" should read --of the handle--.

(2) On page 7, line 8, "second attachment end" should read --of the second attachment end--.

(3) On page 8 (at line 1) and page 10 (at line 8), "is has" should read --has--.

Appropriate correction is required.

### **Claims Objection**

Claims 6, 10 and 11 are objected to because of the following informalities:

(1) In claim 6, line 2, "mounting means" should read --positioning means--.

(2) In claim 10, line 1, "further comprising" should read --said cap further comprising--.

(3) In claim 10, line 2, "ring positioning" should read --ring portion--.

(4) In claim 11, line 1, "removable stand" should read --a removable stand--.

Appropriate correction is required.

### **Claims Rejection - 35 U.S.C. 112, first paragraph**

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(1) In claim 3, the ring portion being "a ball bearing" has no support from the original specification.

(2) In claim 8, the rigid transparent material being "Lucite" has no support from the specification as originally filed.

#### **Claims Rejection - 35 U.S.C. 102(b)**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Prince et al. (U.S. Patent No. 3,922,784).

Prince et al. disclose a cutting device comprising a handle (11) having a first end (14) and a second attachment end (17); a positioning stem (10,21) having a mounting stem (19) and a ring portion (21), the mounting stem (19) positioned on the second attachment end (17) so that the ring portion (21) is spaced a distance from the second

attachment end (17) and defines a notch (see Figs.2 and 3); a cutting means (21,45) rotatably positioned within and removably attached to the ring portion (21); the second attachment end (17) comprising a handle recess (defined between elements 18) for receiving the mounting stem (19); and the cutting means (21,45) comprising a knife having an angled blade (45, see Fig.7) as claimed.

The statements of intended use (i.e. "for use with a template to cut a media", and "when said template notch of said cutting device is inserted into said template, a shape defining edge of said template is received in said template notch") as cited in claim 1 have been carefully considered but deemed not to impose any structural limitations on the claim distinguishable over the Prince et al. reference which shows all the claimed structural limitations.

#### **Claims Rejection - 35 U.S.C. 103(a)**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prince et al. (U.S. Patent No. 3,922,784).

The cutting device of Prince et al. as set forth shows all the claimed structure except it is silent about the material the handle (11) is made of.

However, it would have been obvious to one skilled in the art at the time this invention was made to modify Prince et al. by making the handle (11) of the cutting device out of commercial available transparent plastic material such as "Lucite". Further, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prince et al. (U.S. Patent No. 3,922,784) in view of Dubofsky (U.S. Patent No. 3,111,757).

Prince et al. as set forth shows all the claimed structure except it lacks a removable stand.

Dubofsky shows it is desirable to provide a cutting tool with a removable stand for positioning over one end of the tool handle to facilitate supporting the tool in a vertical position on a horizontal surface when not in use.

In view of this teaching, one skilled in the art who wishes to have the cutting tool of Prince et al. orientated in a vertical position when not in use would have known to provide the cutting tool with a removable stand for the intended purpose set forth.

#### **Indication of Allowable Subject Matter**

1. Claim 3 is rejected under 35 U.S.C. 112, 1<sup>st</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.



2. Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Point of Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for official communications and 571-273-4511 for proposed amendments.

H Payer  
April 21, 2007

*Hwei-Siu Payer*  
Hwei-Siu Payer  
Primary Examiner